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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,439	04/10/2000	Mikael Linden	442-009325-US(PAR)	3336

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Perman & Green
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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT PAPER NUMBER

2134

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/546,439

Applicant(s)

LINDEN ET AL.

Examiner

Matthew Heneghan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-12,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-12,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In response to the previous office action, Applicant has amended claims 1, 9, and 12. Claims 1, 2, 5-12, 17, and 18 have been examined.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, and 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 9 each recite a network element (see preambles) that comprises an interface unit that transmits an attachment signal to the network element. Since the network unit isn't sending a signal to itself, the interface unit should reside outside the network element. Since it is unclear whether or not the interface unit is part of the invention, the scopes of the claims as written are indefinite.

Claims 2, 5-8, 10, and 11 depend from rejected claims 1 and 9, and include all the limitations of those claims, thereby rendering those dependent claims indefinite.

For purposes of the prior art search, it is being presumed that the attachment signal is actually being sent to the external unit, rather than received from it.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 5, 8, 9, 11, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,935,249 to Stern et al.

As per claims 1, 9, and 12, Stern discloses the use of a computer (the external unit) connected to a Java Enabled Network Device (the network element) that downloads drivers such as Java applets from a server and only implements those that are determined by the standard Java libraries to have valid digital signatures before being made available to the computer (see column 10, lines 29-48 and figure 7). The computer contains the "restricted library," to which drivers may be sent and executed.

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The local Java applet is playing the role of a proxy for the server, responding to specific requests of the server as if they had gone over the network and returned from the server (see column 10, lines 49-52). The network connections conform to the OSI Data Layer Model (see column 1, lines 20-22), wherein the format of a transmission is inherently modified at various transmission layers. Java is a type of Application Programming Interface. Since the device sends a request for such objects to a network server, the network address inherently must be sent as part of the request (the address is in Destination address of the Request packets; the server must also have an address to which it should send a reply) (see column 11, lines 13-31). Upon the booting of the network element, a signal may be sent to the computer demanding user authentication, resulting in the transmission of a user cryptographic key to the computer, enabling use of the network element by the user, such as download requests (see column 13, lines 52-57). Tokens (drivers), embodied as applets, requested may also be installed on the network element itself, controlling and monitoring traffic between the computer and the server (see column 9, lines 17-24 and 42-48).

Regarding claim 5, functional Java applets are inherently transmitted in their compiled form as byte-oriented tokens.

Regarding claim 8, a Java applet that is listening to IP traffic must necessarily receive data in a particular format.

Regarding claim 11, the Network Device may store objects for use by clients (see column 12, lines 12-18); in that embodiment, it constitutes a server.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 6, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,935,249 to Stern et al.

Regarding claims 2 and 10, Stern does disclose the use of a portable computer, but does not disclose the use of wireless connections.

Official notice is given that it is well-known in the art to employ wireless networking with portable computers, in order to provide greater mobility.

Therefore it would have been obvious to one of ordinary skill in the art to modify the invention of Stern by using wireless networking, as is well-known in the art, in order to provide greater mobility.

Regarding claims 6 and 7, Stern discloses that a signature must be associated with a particular vendor or application provider, but does not disclose the use of a character string signifying that vendor in the signature generation. Stern further discloses the use of hashes using a manufacturer's key for signature generation (see column 6, lines 3-23).

Official notice is given that the use of character strings as identifying information is well-known in the art, as strings may be used to uniquely identify a sender.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to use character strings as identifying information in digital signatures, as is well-known in the art, in order to uniquely identify a sender.

5. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,935,249 to Stern et al. as applied to claims 1 and 9 and further in view of U.S. Patent No. 6,157,966 to Montgomery et al.

Stern does not disclose what kind of system the host computer is.

Montgomery discloses the use of smart cards as computers for storing programs and executing them using its microcontroller via a terminal (see column 1, line 55 to column 2, line 19) and further notes that this allows for smart cards to be used for such applications as electronic games (see column 1, lines 13-20).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Stern by using a smart card as the host computer, as disclosed by Montgomery, as this allows for smart cards to be used for such applications as electronic games using its own microcontroller.

Response to Arguments

6. Applicant's arguments filed 13 September 2005 have been fully considered but they are not persuasive.

Regarding Applicant's argument that Stern does not disclose drivers in the network element, in the examination of a patent application, the meanings of claim terms are given their broadest reasonable interpretation in light of Applicant's specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en banc). Stern discloses an application in the network element that monitors traffic between the server and external unit and react accordingly, as described above; a driver capable of such functionality constitutes a driver.

Regarding Applicant's argument that Stern's invention does not use an address being passed to the network element for a download, it is noted that, since the external device is interfacing to the network element as it would a server and since the network element is being used as a proxy for a server, the external device must therefore sends it download request as though it is a request to the server itself. Any such request must, therefore, include some addressing information intended for the server being accessed. By simply relaying the address of the server as received from the external unit, the interface unit of the network element provides an address.

Regarding Applicant's argument that the use of addresses in data transfers is not inherent, Evidence of the inherency of addresses being used in data transfers is given in Postel et al., RFC 959, "File Transfer Protocol (FTP)," 1985. Postel discloses that a connection is defined by the addresses, and the "PORT" field is used for that address.

See p. 19, Section 3.3, second paragraph. The FTP transfer is initiated using the address of the other endpoint; the Examiner is unaware of any protocol for accessing a random server that does not do likewise.

Regarding Applicant's argument that Montgomery's smartcard is not a computer, it is noted that the smartcard can run programs, as Applicant has argued. It therefore constitutes a computer.

Regarding Applicant's argument that one skilled in the art would not be motivated to combine Stern and Montgomery, it is noted that Stern is not specific about which type of computer should be used as the external device, and the external device may be used to play games (see column 10, lines 44-46); Montgomery's smartcard runs Java (see column 6, lines 19-21). The inventions are sufficiently analogous that one skilled in the art would see a benefit in combining them.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached at (571) 272-3799.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

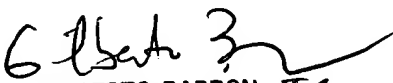
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH



November 3, 2006



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